

Defendant T-Mobile USA, Inc. (“T-Mobile”), by and through its counsel, respectfully moves the Court to stay the above-captioned action pending the completion of the *inter partes* reexamination of U.S. Patent Nos. 6,847,822 (“the ’822 Patent”) and 7,289,763 (“the ’763 Patent”) (collectively, the “patents-in-suit”) by the U.S. Patent and Trademark Office (“PTO”). The accompanying brief sets forth at least the following grounds warranting a stay of this action:

1. Both of the patents-in-suit are now subject to reexamination. Nearly all of the asserted claims of the ’822 Patent currently stand rejected by the PTO in ongoing *inter partes* reexamination proceedings; and all of the asserted claims of the ’763 Patent are subject to a separate request for *inter partes* reexamination filed on December 14, 2010. Among other occurrences that have led to the instant motion (which are more fully set forth in the accompanying brief in support), Plaintiffs filed a second amended complaint against T-Mobile on December 17, 2010, and served updated infringement contentions on January 7, 2011, confirming that infringement allegations as to two other patents that were previously in suit were being dropped from this case, leaving the only two patents remaining in suit both subject to reexamination.¹ Accordingly, this Motion is being filed expeditiously.

2. Three other cases filed by Plaintiffs in this District and pending before Judge Lioi, all involving both of the patents-in-suit, have all already been stayed pending reexamination of the patents-in-suit. (Case Nos. 08-CV-816-SL, 08-CV-818-SL, and 08-CV-822-SL).

3. During reexamination, the PTO will determine whether the asserted claims of the patents-in-suit are patentable over the reexamination prior art while considering the appropriate priority date for each of the asserted claims. The PTO is statutorily required to conduct the reexamination proceedings “with special dispatch.” 35 U.S.C. § 314(c). It is highly likely that

¹ Plaintiffs also filed a motion for leave to file a third amended complaint on January 13, 2011, reflecting their updated contentions. (D.I. 163.)

once the proceedings are complete, the PTO will either cancel or narrow the claims of both patents-in-suit, or even invalidate one of the patents-in-suit entirely.

4. All of the factors that this Court considers on such motions to stay weigh in favor of granting a stay in these cases, including: (1) a stay will simplify the issues in question and trial of the case; (2) a stay will not unduly prejudice or present a clear tactical disadvantage to Plaintiffs; and (3) discovery has not yet closed and no trial date has been set.

5. Absent a stay, substantial resources of the Court and the parties will be expended in trying issues related to infringement and validity of patent claims that may ultimately be canceled or narrowed by the PTO.

6. Under these circumstances, a stay of this litigation is consistent with the law of this Court and in the interest of judicial economy.

WHEREFORE, for the reasons set forth herein, T-Mobile respectfully requests that this Court enter an Order:

- A. Staying this litigation pending the completion of the reexaminations of the patents-in-suit, except with regard to the depositions of Warren Williamson III and Terry M. Gernstein, to be taken by Plaintiffs or Defendants or both; and
- B. Granting T-Mobile such other and further relief as is just and appropriate.

Dated: January 18, 2011

Respectfully submitted,

By /s/ John M. Skeriotis

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CERTIFICATE OF SERVICE

I certify that on January 18, 2011, a copy of the foregoing was filed electronically. Notice of this filing will be sent to all parties by operation of the Court's electronic filing system. Parties may access this filing through the Court's system.

/s/ John M. Skeriotis

One of the Attorneys for Defendant
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